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EXAMINER	
POKRZYWA, JOSEPH R	
ART UNIT	**PAPER NUMBER**
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21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/468,257	Applicant(s) HANSON ET AL.	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-5,7-20,22 and 24-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2-4,15,22,24,31 and 33* is/are allowed.

6)☒ Claim(s) *5,7-14,16-20,25-30,32,34 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 5/04/04, and has been entered and made of record. Currently, **claims 2-5, 7-20, 22, and 24-35** are pending.

Response to Arguments

2. Applicant's arguments, see pages 12-14, filed 5/4/04, with respect to the rejection of **claim 15** have been fully considered and are persuasive. Therefore, the rejection of **claim 15**, as well as the rejection of **claims 2-4, 22, 24, 31, and 33** has been withdrawn. Upon reconsideration, the examiner notes that Knowles fail to expressly disclose of determining whether a first communication address is available, and when it is not, sending the second communication address for a different type of communication mode.

3. Applicant's arguments with respect to the rejection of **claims 5, 7-14, 16-20, 25-30, and 32**, filed 5/4/04 have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of independent **claims 5, 11, 20, and 25-28**, as being anticipated by Knowles *et al.* (U.S. Patent Number 5,869,819), whereby applicant argues on page 11 that Knowles fails to teach that the claimed steps are implemented in the sequence that they are listed. The examiner notes that the current claim language, as amended, now requires the steps executed sequentially. Upon review of the reference Knowles, the examiner believes that the reference still can be interpreted as teaching this limitation. Particularly, in column 16, lines 38 through 40, Knowles reads that "the bar code menu can be

printed out locally and then transmitted to a remote location by way of facsimile transmission for print out and subsequent use." With this, the remote location is interpreted as the final addressee destination of a fax, whereby the remote location, for it's "subsequent use", performs the scanning, decoding, selecting of a communication address, and initiating a communication. By interpreting the claim in this way, the subsequent limitations can be seen to follow in sequential order, as no required in the claim language.

5. Therefore, the rejection of **claims 5, 11, 20, and 25-28**, as cited in the Office action dated 2/4/04 under 35 U.S.C. 102(e), as being anticipated by Knowles *et al.*, are maintained and repeated in this Office action.

6. In response to the applicant's arguments regarding the rejection of dependent **claim 10**, whereby applicant argues on page 11 that Knowles fails to teach that all of the bar code is invisible. Currently, claim 10 requires that "said communication mark is not visible to the unaided human eye." First, the examiner notes that the claim does not require that a bar code is invisible, as argued by applicant, but rather that a communication mark not visible. In the rejection cited in the Office dated 2/4/04, Knowles is shown to teach in column 17, lines 44 through 50, that the character string length of a URL, in this instance being interpreted as the communication mark, can be shortened. Thus, some of the URL is not visible to the human eye. Because the entire URL is interpreted as the communication mark, the claim as currently worded can be interpreted as being taught by Knowles, since the full URL is not visible to the human eye, but rather, only a shortened portion.

7. Therefore, the rejection of **claim 10**, as cited in the Office action dated 2/4/04 under 35 U.S.C. 102(e), as being anticipated by Knowles *et al.*, is maintained and repeated in this Office action.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 5, 7-14, 16-20, 25-30, 32, and 34** are rejected under 35 U.S.C. 102(e) as being anticipated by Knowles *et al.* (U.S. Patent Number 5,869,819, cited in the Office action dated 2/4/04).

Regarding ***claim 5***, Knowles discloses a method for providing automatic communication addressing comprising sequentially executing the steps of receiving at a final addressee destination a document from a sending party from one from the group of a fax and an email communication and creating a hardcopy of the document (column 16, lines 25 through 46, seen in Figs. 6A and 6B), without adding any address information, scanning the document to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on the hardcopy (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31), decoding the communication mark to obtain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from the communication mark (see Fig. 6B, column 14, lines 27 through 56, and column 17, lines 51 through 61, wherein the first communication mode is the address indicating a WWW information server while the second communication

mode is an address indicating a FTP information server; alternatively, see Fig. 16, abstract, and column 22, lines 11 through 33, wherein the URL is a first communication mode, and the ZIP Code is a second communication mode), wherein the communication addresses are different from that of the final addressee destination (column 9, lines 11 through 23, and column 15, lines 6 through 40), selecting one of the communication addresses and inputting the selected communication address into an address function of a communication device (column 9, lines 11 through 48), and initiating a communication to the communication address through the communication device (column 9, lines 11 through 65).

Regarding ***claim 7***, Knowles discloses the method discussed above in claim 5, and further teaches that the communication device comprises at least two different types of communication modes (see Fig. 6B, column 14, lines 27 through 56, and column 17, lines 51 through 61, wherein the first communication mode is the address indicating a WWW information server while the second communication mode is an address indicating a FTP information server; alternatively, see Fig. 16, abstract, and column 22, lines 11 through 33, wherein the URL is a first communication mode, and the ZIP Code is a second communication mode).

Regarding ***claim 8***, Knowles discloses the method discussed above in claim 5, and further teaches of the step of adding a communication mark to the information prior to initiating the communication (column 16, lines 8 through 46).

Regarding ***claims 9 and 10***, Knowles discloses the method discussed above in claim 5, and further teaches that the communication mark is a bar code (column 9, lines 11 through 48, see Figs. 1 and 1A), and that the communication mark is not visible to the unaided human eye (column 17, lines 44 through 50, wherein the character string length of a URL, being the

communication mark, is shortened, thereby making the communication mark of the full URL not visible to the unaided human eye).

Regarding ***claim 11***, Knowles discloses a method for providing automatic communication addressing comprising sequentially executing the steps of receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document at a final addressee destination (column 16, lines 25 through 46, seen in Figs. 6A and 6B), without adding any information, scanning the document to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on the hardcopy (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31), decoding the communication mark to obtain at least one Internet address from the communication mark that is different from the final addressee destination (column 9, lines 11 through 23, column 11, line 64 through column 12, line 33, and column 15, lines 6 through 40), automatically accessing a site for the Internet address and retrieving at least one communication address (column 9, lines 11 through 65), inputting the communication address into an address function of a communication device (column 9, lines 11 through 65), and initiating a communication of the information to the communication address through the communication device (column 9, lines 11 through 65), wherein the communication mark is a storage address to a location where an external communication address is stored (column 9, line 66 through column10, line 20, and column 10, line 53 through column 11, line 4).

Regarding ***claim 12***, Knowles discloses the method discussed above in claim 11, and further teaches of a step of accessing the storage address over a network to obtain the communication address (column 18, lines 1 through 20).

Regarding ***claim 13***, Knowles discloses the method discussed above in claim 11, and further teaches of a step of accessing a URL address wherein the communication device is located (column 9, lines 11 through 65).

Regarding ***claim 14***, Knowles discloses the method discussed above in claim 5, and further teaches that the communication device is a voice communication device (column 8, lines 27 through 47, whereby the hypermedia documents in the web site includes audio information).

Regarding ***claim 16***, Knowles discloses the method discussed above in claim 5, and further teaches of the step of storing the address obtained directly or indirectly from the communication mark (column 9, lines 27 through 38).

Regarding ***claim 17***, Knowles discloses the method discussed above in claim 5, and further teaches of the step of determining a name of an addressee corresponding to the obtained address (column 14, lines 8 through 46), and displaying the addressee name to a user (see Figs. 6A and 6B).

Regarding ***claim 18***, Knowles discloses the method discussed above in claim 5, and further teaches of the step of adding a new communication mark to the information includes directly or indirectly a new address to be obtained relative to the obtained at least one address (see Figs. 6A and 6B, column 14, lines 8 through 56, and column 17, lines 51 through 61).

Regarding ***claim 19***, Knowles discloses the method discussed above in claim 5, and further teaches of the step of adding a communication mark to the information that deletes an address or a reference to an address from the located communication mark (column 15, line 6 through column 16, line 24, wherein the user can select what information and the display format of the printed information file, therein inherently including adding a communication mark to the

information that deletes an address or a reference to an address from the located communication mark; also in column 17, lines 44 through 50, the character string length of the URLs can be shortened, thus deleting a reference to an address).

Regarding ***claim 20***, Knowles discloses a system for providing automatic communication addressing comprising sequentially operating logics comprising logic for locating a non-text/image communication mark on a medium containing information and which has been sent to a final addressee destination from a sending party (column 16, lines 25 through 46, seen in Figs. 6A and 6B), wherein the communication mark includes a first communication address for a first communication mode, and second communication address for a second different type of communication mode (see Fig. 6B, column 14, lines 27 through 56, and column 17, lines 51 through 61, wherein the first communication mode is the address indicating a WWW information server while the second communication mode is an address indicating a FTP information server; alternatively, see Fig. 16, abstract, and column 22, lines 11 through 33, wherein the URL is a first communication mode, and the ZIP Code is a second communication mode), and wherein the first communication address and the second communication address are different from that of the final addressee destination (column 9, lines 11 through 23, and column 15, lines 6 through 40), logic for obtaining at least one address directly or indirectly from the communication mark (see Fig. 6B, column 14, lines 27 through 56, and column 17, lines 51 through 61), logic for inputting the address into an address function of a communication device (column 9, lines 11 through 48), and logic for initiating a communication of the information to the address through the communication device (column 9, lines 11 through 65).

Regarding ***claim 25***, Knowles discloses a program product for providing automatic communication addressing, comprising machine-readable program code for causing a machine to perform the following sequence of operations (column 8, line 27 through column 9, line 48), comprising receiving at a final addressee destination a document from a sending party from one from the group of a fax and an email communication and creating a hardcopy of the document (column 16, lines 25 through 46, seen in Figs. 6A and 6B), without adding any address information, scanning the document to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on the hardcopy (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31), decoding the communication mark to obtain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from the communication mark (see Fig. 6B, column 14, lines 27 through 56, and column 17, lines 51 through 61, wherein the first communication mode is the address indicating a WWW information server while the second communication mode is an address indicating a FTP information server; alternatively, see Fig. 16, abstract, and column 22, lines 11 through 33, wherein the URL is a first communication mode, and the ZIP Code is a second communication mode), wherein the communication addresses are different from that of the final addressee destination (column 9, lines 11 through 23, and column 15, lines 6 through 40), selecting one of the communication addresses and inputting the selected communication address into an address function of a communication device (column 9, lines 11 through 48), and initiating a communication to the communication address through the communication device (column 9, lines 11 through 65).

Regarding ***claim 26***, Knowles discloses a program product for providing automatic communication addressing, comprising machine-readable program code for causing a machine to perform the following method comprising sequentially executing operations (column 8, line 27 through column 9, line 48), comprising receiving at a final addressee destination a document from a sending party from one from the group of a fax and an email communication and creating a hardcopy of the document (column 16, lines 25 through 46, seen in Figs. 6A and 6B), without adding any information, scanning the document to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on the hardcopy (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31), decoding the communication mark to obtain at least one Internet address from the communication mark (column 9, lines 11 through 23, column 11, line 64 through column 12, line 33, and column 15, lines 6 through 40), automatically accessing a site for the Internet address and retrieving at least one communication address (column 9, lines 11 through 65), wherein the at least one address is different from that of the final addressee destination (column 9, line 66 through column10, line 20, and column 10, line 53 through column 11, line 4), inputting the communication address into an address function of a communication device (column 9, lines 11 through 65), and initiating a communication of the information to the communication address through the communication device (column 9, lines 11 through 65).

Regarding ***claim 27***, Knowles discloses a system for providing automatic communication addressing comprising sequentially executing logics comprising logic for receiving at a final addressee destination a document from a sending party from one from the group of a fax and an email communication and creating a hardcopy of the document (column 16, lines 25 through 46,

seen in Figs. 6A and 6B), logic for, without adding any address information, scanning the document to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on the hardcopy (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31), logic for decoding the communication mark to obtain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from the communication mark (see Fig. 6B, column 14, lines 27 through 56, and column 17, lines 51 through 61, wherein the first communication mode is the address indicating a WWW information server while the second communication mode is an address indicating a FTP information server; alternatively, see Fig. 16, abstract, and column 22, lines 11 through 33, wherein the URL is a first communication mode, and the ZIP Code is a second communication mode), wherein the communication addresses are different from that of the final addressee destination (column 9, lines 11 through 23, and column 15, lines 6 through 40), logic for selecting one of the communication addresses and inputting the selected communication address into an address function of a communication device (column 9, lines 11 through 48), and logic for initiating a communication to the communication address through the communication device (column 9, lines 11 through 65).

Regarding ***claim 28***, Knowles discloses a system for providing automatic communication addressing, comprising sequentially executed logics comprising logic for receiving at a final addressee destination a document from a sending party from one from the group of a fax and an email communication and creating a hardcopy of the document (column 16, lines 25 through 46, seen in Figs. 6A and 6B), logic for, without adding any information, scanning the document to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on

the hardcopy (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31), logic for decoding the communication mark to obtain at least one Internet address from the communication mark (column 9, lines 11 through 23, column 11, line 64 through column 12, line 33, and column 15, lines 6 through 40), logic for automatically accessing a site for the Internet address and retrieving at least one communication address (column 9, lines 11 through 65), wherein the at least one address is different from that of the final addressee destination (column 9, line 66 through column10, line 20, and column 10, line 53 through column 11, line 4), logic for inputting the communication address into an address function of a communication device (column 9, lines 11 through 65), and logic for initiating a communication of the information to the communication address through the communication device (column 9, lines 11 through 65).

Regarding ***claim 29***, Knowles discloses the method discussed above in claim 5, and further teaches that the communication device is a facsimile (column 4, lines 34 through 42, and column 16, lines 25 through 46), the document is a fax (column 16, lines 25 through 46), and wherein the communication addresses at least include a communication address of the sending party (column 15, line 50 through column 16, line 46).

Regarding ***claim 30***, Knowles discloses the method discussed above in claim 5, and further teaches that the communication mark is a non-text/image communication mark (column 9, line 66 through column 10, line 20, and column 17, lines 16 through 31, whereby the communication mark is a bar code).

Regarding ***claim 32***, Knowles discloses the system discussed above in claim 20, and further teaches of obtaining the at least one Internet address directly from the communication mark (column 9, lines 11 through 65).

Regarding ***claim 34***, Knowles discloses the system discussed above in claim 28, and further teaches that the information which is not added is address information (column 8, line 55 through column 9, line 38, and column 17, lines 4 through 31, whereby a URL encoded bar code symbol 8 is address information, which is not added).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claim 35** is rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles *et al.* (U.S. Patent Number 5,869,819, cited in the Office action dated 2/4/04) in view of Wang *et al.* (U.S. Patent Number 5,513,264).

Regarding ***claim 35***, Knowles teaches the method discussed above in claim 5, but fails to specifically teach if the communication mark is completely invisible to the unaided human eye.

Wang discloses a method that receives at a final addressee destination a document from a sending party from a fax communication and creates a hardcopy of the document (column 4, lines 23 through 56), scans the document to obtain at least one communication mark (column 4, line 57 through column 5, line 33), if one is present, on the hardcopy, and decodes the communication mark (column 5, line 34 through column 6, line 36). Further, Wang teaches that the communication mark is completely invisible to the unaided human eye (column 4, lines 38

through 56, wherein by printing a bar code using an invisible bar code printer, the communication mark is completely invisible to the human eye).

Knowles & Wang are combinable because they are from the same field of endeavor, that being systems that use encoded bar codes to communicate information to a reception device.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Wang in the system of Knowles.

The suggestion/motivation for doing so would have been that the system of Wang would become more secure with the inclusion of Wang's invisible bar codes, as data encoded in the bar code would be invisible to humans, therein not allowing humans to view the information, so as to prevent any stealing or tampering with the code.

Therefore, it would have been obvious to combine the teachings of Wang with the system of Knowles to obtain the invention as specified in claim 35.

Allowable Subject Matter

12. **Claims 2-4, 15, 22, 24, 31, and 33** are allowed.

13. The following is a statement of reasons for the indication of allowable subject matter:

Regarding independent ***claims 15, 22, and 24***, in the examiner's opinion, it would not have been obvious to one of ordinary skill in the art to have the system, as claimed, include determining whether a first communication address is available, and when it is not, sending the second communication address for a different type of communication mode.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
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jrp

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